

REMARKS

Claims 1 through 25 are pending in this application. The Applicant appreciates the indication of allowance of claims 4 through 7, 9 through 15, 19 through 21, 24 and 25.

I. CLAIM REJECTIONS - 35 U.S.C. § 102

Claims 1, 8, 16-18, 22-23 were rejected under 35 U.S.C. §102(b) as being anticipated by Dornier (U.S. Patent 5,646,535). The Applicant respectfully traverses.

No claim is anticipated under 35 U.S.C. §102 (b) unless all of the elements are found in exactly the same situation and united in the same way in a single prior art reference. As mentioned in the **MPEP §2131**, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as complete detail as is contained in the patent claim. *Id.*, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.

The examiner in his response to the arguments in paper number 11 contends that a personal

computer encompasses the device of a portable computer. The Examiner states that a portable computer is defined by the examiner as a computer that can be moved from one place to another without losing functionality. The Examiner states that the personal computer used by Dornier can be transported and have the same capabilities in any end destination. Therefore, the examiner contends that the personal computer of Dornier fulfills the limitation of the present invention.

However, even if we were to use the Examiner's definition of a "portable computer", Dornier does not make such a disclosure. In Dornier, personal computer is disclosed in col. 1, line 56, col. 2, lines 21-22, 50-51 and 64. However, Dornier never discloses that the personal computer can be moved from one place to another without losing functionality. The Examiner stated that the personal computer in Dornier can be transported without losing functionality. However, nothing in Dornier including for example section around col. 1, line 56, col. 2, lines 21-22, 50-51 and 64, discusses the transportation of the personal computer 11. In fact Figure 1 of Dornier clearly shows a desktop computer for reference 11.

The present invention, on the other hand mentions in claim 1 and 16 for example, *operating states of the portable computer*. 35USC102 mandates that the identical invention be disclosed where each and every element must be disclosed as arranged in the claims. As mentioned in MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." The single reference must disclose the "portable" computer and not the Examiner's personal knowledge or conjecture. A transportable personal computer that does not lose its functionality is never disclosed in Dornier itself. According to 37CFR§1.104, "When a rejection in an application is based on facts within the personal

knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.” Therefore, if such a rejection is based on the Examiner’s personal knowledge rather than the reference of Dornier, then the Applicant asks the Examiner to provide an affidavit. Furthermore, to use personal knowledge in the rejection would also be improper since only a single reference can be used in the rejection.

Therefore, since the present invention claims *portable computer* and Dornier discloses only a personal computer that is not a portable computer, Dornier does not anticipate the claims of the present invention.

Furthermore, according to the definition in the IEEE standard dictionary of electrical and electronics terms, the portable computer is configured to permit transportation as a piece of handheld luggage. Clearly, figure 1 of Dornier is not capable of such transportation especially since there is no display or monitor shown that can be portably used with Dornier.

The Examiner on page 6 of paper number 11 stated that the Applicant has argued that Dornier does not disclose each power-on self-test code corresponding to a specific light emitting diode. The examiner disagrees because in the invention of Dornier, each LED state is responsive to each part of a POST routine (column 1, line 62 - column 2, line 12). The examiner interprets each part of the POST routine to be equivalent to the code claimed in the present invention.

However, column 1, line 62 - column 2, line 12 states that by using on-off and color states

of the LEDs, the execution of the different parts of the POST routine can be followed. However, this does not mean that *each power-on self-test code corresponding to a specific light emitting diode* as shown in claim 17 of the present invention. According to Dornier, a single LED may correspond to multiple POST codes or multiple LEDs correspond to a single POST code. Dornier clearly elaborates in col. 3, lines 59-63, "Hence, if the LED status remains LED 23 yellow and LED 25 red, the user will know the BIOS checksum failed, which will be valuable diagnostic information." Clearly here two different LEDs are needed to show the checksum and therefore, a cumbersome set of colors and sequences must be known in order to decipher the error. Both the on-off and color status are used as mentioned in col. 3, lines 25-30 which states that 16 messages can be displayed by the combination of tri-state LEDs. Therefore, clearly each POST code does not correspond to a specific LED in Dornier.

The standard for an anticipation rejection is high in that the identical invention must be shown in as complete detail as is contained in the patent claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). Therefore, since the identical invention is not disclosed, respectfully, claims 1, 8, 16-18, 22-23 are not anticipated by Dornier.

II. REJECTION OF CLAIMS (35 U.S.C. § 103)

Claims 2 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dornier (U.S. Patent 5,646,535) in view of Kang (U.S. Patent 6,434,696). The Applicant respectfully

traverses.

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

On page 6 of paper number 11, the Examiner stated that the Applicant has argued that neither Dornier nor Kang are activating a display of power-on self-test codes on the indicating device in response to a key input and that "The examiner contends that when the system of Kang is reset, the entire system including the POST operations. Since the POST resets, the display LED's will also

reset and activate a display as it did in the primary boot.” Therefore, concerning claims 2 and 3, the Examiner is stating that Kang teaches or suggests *a key input device coupled to said controller, said key input activating a display of power-on self-test codes on the indicating device in response to a key input signal from the key input device.*

The Examiner argues that the POST codes are displayed in Kang as when it is booted and therefore, the key is activating a display of the POST code. The key in Kang is activating the POST process which may be displayed but the actual activation of the display of the POST code is not activated by the key in Kang. Furthermore, Kang never teaches that the POST code is ever even displayed on a display. Kang only mentions of a video output display 6 of the related art and not the Kang invention in col. 1, line 25-26, figure 1, that generically displays “information” but nothing stating POST codes. In col. 1, lines 60-67 Kang mentions that the BIOS codes include a plurality of computer routines for controlling devices such as system clock, video output display 6, disk controller 5, *etc.* However, nothing is taught or suggested that the key activates the display of POST codes. Furthermore, Kang is trying to teach away from the teachings of the conventional art of figure 1.

This teaching is notable if it is to be modified by Dornier to be a display having a plurality of LEDs. Kang is teaching of a key input for executing a reset of the machine and then the reset initiates the BIOS codes for post and not *activating a display of power-on self-test codes on the indicating device in response to a key input*. Kang is still not teaching or suggesting of activating the display but of the process.

If the Examiner is relying on his personal knowledge, then according to 37CFR§1.104, the

Applicant has the right to ask for an affidavit concerning the personal knowledge because according to MPEP 706.02(j), the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Respectfully, as mentioned above in *In re Wood*, it is the teaching and not just the bodily incorporation of one reference into another that matters concerning obviousness. 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979).

Furthermore, Dornier only teaches or suggests of a personal computer which as seen by figure 1 is a desktop computer. Claims 2 and 3 of the present invention on the other hand claim a portable computer. Looking at Kang, there is only a mention of a personal computer (col. 3, line 66) with no further description of a portable computer. Even if Kang did teach or suggest a portable computer, there is still no teaching of a portable computer with the limitations of the present invention. The Federal Circuit has mentioned that “[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference...Rather, we look to see whether combined teachings render the claimed subject matter obvious.” *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (CCPA 1964). Therefore, looking at the combination references there is no teaching or suggestion of a portable computer that has the limitations of the claims.

The present application mentioned on page 3, lines 4-7 that generally POST cards are plugged in desktop computers and on page 3, lines 8-13, “if a portable computer such as a laptop and

notebook computer, the POST card is pugged in an extension slot coupled to a docking station.” The docking station makes the portable computer no longer portable, but essentially a desktop computer. As seen in Dornier, the art is still disclosing the desktop style computers that are not portable.

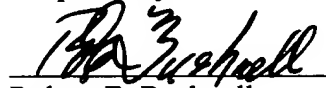
Furthermore, in claim 3, the combination of Dornier and Kang does not teach or suggest *each power-on self-test code corresponding to a specific light emitting device* among the plurality of light emitting devices. As mentioned above, Dornier for instance in col. 4, lines 21-41 states that certain on and off changes and combinations and certain colors at particular times display the particular group of tests. Therefore, a user will still have to know what combination of colors or sequence of lights in combination *etc.* will represent a certain state. Therefore, even in Dornier as seen in the earlier POST cards, one still must decipher the code or sequence. Dornier does not disclose each POST corresponding to a specific indicator. The present invention on the other hand according to claim 3 has each power-on self-test code corresponding to a specific light emitting diode which makes it much easier to appreciate the state or error in the POST. Kang also makes no teaching or suggestion of each POST corresponding to a specific light emitting device among the plurality of light emitting devices.

Therefore, respectfully, claims 2 and 3 are not obvious with respect to the combination of references Dornier and Kang.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

No fee is incurred by this Response. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,


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